

Paper No. 18
BAC

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Systems Integration Solutions, Inc.

Serial No. 74/575,862

Shirley J. Su of Howard, Rice, Nemerovski, Canady, Falk &
Rabkin, P.C. for Systems Integration Solutions, Inc.

Angela Lykos, Trademark Examining Attorney, Law Office 102
(Thomas Shaw, Managing Attorney)

Before Simms, Quinn and Chapman, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Systems Integration Solutions, Inc. has filed an
application to register the mark SYSTEMS INTEGRATION
SOLUTIONS, INC. for "consulting services in the field of

information technology, computer systems and software development".¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its identified services, so resembles the previously registered mark INTEGRATED SYSTEMS SOLUTIONS for "information systems services; namely, consulting, computer systems operations for computer outsourcing, and computer applications development"² as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register. In reaching this conclusion, we have considered all of the relevant du Pont³ factors.

Applicant essentially contends that the two marks are different in sound, appearance, and meaning; that the registered mark is "highly suggestive and weak"; that the registered mark is entitled to a limited scope of

¹ Ser. No. 74/575,862, filed September 19, 1994. The claimed dates of first use and first use in commerce are April 1, 1990. Applicant disclaimed the words "systems integration" and the word "Inc.".

² Reg. No. 1,854,331, issued September 13, 1994. The claimed dates of first use and first use in commerce are June 4, 1991. The words "integrated systems" are disclaimed.

³ See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973).

protection because there are numerous third-party registrations of similar marks in the computer-related services area; that applicant and registrant actually provide different services which are offered through different channels of trade; that the respective services are expensive and are carefully selected by "sophisticated corporate executives"; and that applicant is unaware of any instances of actual confusion in the five years both marks have been used. In support of its arguments, applicant submitted, inter alia, the declaration of Gerald E. Heath, Jr., applicant's president and chief executive officer, including exhibits consisting of photocopies of fourteen third-party registrations; and a brochure obtained from the registrant and information obtained from registrant's web site on the Internet.

It is the Examining Attorney's position that the involved services are identical, both involving consulting services in the computer field; that the involved marks are similar in appearance, connotation, and commercial impression; that the third-party registrations submitted by applicant can be distinguished from the cited registration; that the purported sophistication of the consumers is not determinative; and that actual confusion (or lack thereof)

is not the test, rather the test is likelihood of confusion.

Turning first to a consideration of the involved services, applicant's services are "consulting services in the field of information technology, computer systems and software development"; and the services in the cited registration are "information systems services; namely, consulting, computer systems operations for computer outsourcing and computer applications development". Clearly both identifications refer to consulting services with regard to information technology and computer systems and applications.

In determining the question of likelihood of confusion in an ex parte case, the Board is constrained to compare the services as identified in the application with the services as identified in the cited registration. If the registrant's services and the applicant's services are described so as to encompass or overlap, then applicant cannot properly argue that, in reality, the actual services of the applicant and registrant are not similar. See *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *In re Trackmobile Inc.*, 15 USPQ2d 1152 (TTAB 1990);

and Peopleware Systems, Inc. v. Peopleware, Inc., 226 USPQ 320 (TTAB 1985).

Applicant's argument that its identification of services and the cited registrant's identification of services "are different from each other and require additional evidence to clarify the descriptions" (applicant's brief, footnote 23) is not convincing.⁴ We agree with applicant that the identifications involved herein do not utilize precisely the same words. However, we disagree with applicant that the identifications of services are ambiguous or unclear. Both of the recitations of services clearly involve consulting services relating to various aspects of the computer industry.⁵

⁴ Applicant's president averred in his declaration that "applicant's role is similar to that of an employment agency placing temporary contract employees for three-month periods to assist with projects designed and managed by the client company"; and in applicant's brief, pages 2-3, applicant's attorney stated that "Applicant's business is supplying temporary 'contract employees' to supplement existing in-house corporate management information systems ('MIS') departments in projects such as software applications design, development and implementation". While applicant's identification of services is broadly worded, clearly employment agency services are not within the scope of applicant's "consulting services". See *In re Swen Sonic Corp.*, 21 USPQ2d 1794 (TTAB 1991). To whatever extent applicant is attempting to effectively limit or change its identification of services by going outside the identification applicant itself set forth in its application, it is not permitted.

⁵ Applicant's situation in this case differs from the case cited by applicant, *In re Fieldcrest Cannon Inc.*, 5 USPQ2d 1142 (TTAB 1987), which involved not only ambiguous identifications of goods, but also a written consent agreement.

It is well settled that services need not be identical or even competitive to support a finding of likelihood of confusion. It is sufficient that the services are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See *In re Peebles Inc.*, 23 USPQ2d 1795, 1796 (TTAB 1992); and *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 596 (TTAB 1978).

Turning then to a consideration of the respective marks, applicant's mark SYSTEMS INTEGRATION SOLUTIONS, INC. and the registered mark INTEGRATED SYSTEMS SOLUTIONS are similar in connotation and appearance. The words "systems integration" and "integrated systems" connote the integration of various systems (in this case, especially with regard to computer systems and applications). And the term "solutions" connotes the idea that the purchaser of the computer-related consulting services would be hiring a company that can solve whatever problem or situation resulted in its seeking out a consulting service.

Applicant argues that the marks have different meanings because the words 'systems integration' in applicant's mark "suggest a process by which a company is

integrating its systems" and applicant's contract employees assist in that process; whereas, in the cited registration, the words 'integrated systems' "refer to a completed system, or an end product, which is provided by Registrant" (applicant's brief, p. 7). This is merely argument by applicant's counsel. This record contains no evidence from people in the business who are knowledgeable about the meanings of these marks; nor is there any evidence of general consumer understanding of these words.

Regarding the appearance of the two marks, it is true that the marks are not identical. However, both marks contain essentially the same three words, SYSTEMS, INTEGRATION/INTEGRATED, and SOLUTIONS. (We do not believe the word "Inc." adds any significant feature to applicant's mark.) While the two words "integrated systems" and "systems integration" are reversed, this, as well as the additional word "Inc." in applicant's mark, does not distinguish the two marks. Because both marks convey the same connotation, purchasers are unlikely to remember these slight differences between the marks. Under actual market conditions, consumers generally do not have the luxury of making side-by-side comparisons. See Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate

Corporation, 206 USPQ 255, 259 (TTAB 1980). The commercial impression created by the marks is essentially the same.⁶

None of the fourteen third-party registrations submitted by applicant⁷ are for marks identical to the marks here in issue, and many of the third-party registrations cover goods such as solid state electronics, and different computer programs, or they cover services such as the repair of computer hardware and software, the installation of computers for others, and training in the field of computer software. Some of the third-party registrations do include some type of computer consulting services, but, as explained above, none of the third-party registered marks are the same as the two marks involved herein. That is, there are no third-party registrations which include all three words, SYSTEMS, INTEGRATION or INTEGRATED, and SOLUTIONS.

⁶ Applicant's argument that its mark consists of a noun followed by an adjective, and that the cited registrant's mark is an adjective followed by a noun is not persuasive, and we believe the marks will not be so analyzed by the purchasing public.

⁷ In applicant's request for remand (filed September 26, 1996) and granted by the Board on October 30, 1996, applicant specifically requested that the Board take judicial notice of all 28 exhibits attached to applicant's request for remand. Applicant is advised that judicial notice is not necessary once evidence has been submitted for consideration of the Examining Attorney, and the matter has been remanded to the Examining Attorney. The evidence then forms part of the record of the ex parte case.

Moreover, it is well settled that third-party registrations are not evidence of commercial use of the marks shown therein, or that the public is familiar with them. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, footnote 6 (TTAB 1988). Applicant submitted neither evidence of use by third parties nor evidence of awareness by the public of these various third-party registrations. Therefore, we cannot conclude that the public is so familiar with marks containing the words SYSTEMS, INTEGRATION/INTEGRATED and SOLUTIONS that they distinguish such marks on the basis of small differences.

Even if the prospective purchasers of the involved services are sophisticated, and the services are expensive, as argued by applicant, this does not mean that they are immune from confusion as to the source of the consulting services offered by applicant and the cited registrant. See *Peopleware Systems, Inc.*, *supra*; and *In re Pellerin Milnor Corporation*, 221 USPQ 558 (TTAB 1983).

Applicant's argument regarding the lack of actual confusion is likewise not persuasive because the test is likelihood of confusion, not actual confusion. And, of course, on an *ex parte* record, the Board has no information from the registrant on this question.

We find that the same person may seek applicant's and the cited registrant's services; and upon seeing the substantially similar marks SYSTEMS INTEGRATION SOLUTIONS, INC. and INTEGRATED SYSTEMS SOLUTIONS for the respective services may believe the services emanate from or are otherwise sponsored by or affiliated with the same source.

Decision: The refusal under Section 2(d) is affirmed.

R. L. Simms

T. J. Quinn

B. A. Chapman
Administrative Trademark Judges,
Trademark Trial and Appeal Board